

## **REMARKS**

### **1. Summary of the Office Action**

In the Office Action mailed July 17, 2007, (i) the Examiner indicated that should claims 5 (or 8) be found allowable, claim 6 (or 16) will be objected to under 37 C.F.R. § 1.75 as being a substantial duplicate thereof, (ii) the Examiner objected to claims 39, 43, 45, and 48-52 for claim informalities, (iii) the Examiner rejected claims 14, 19, 25, 26, 30, 31, 34, 36, 37, and 39 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention, (iv) the Examiner rejected claims 1-25, 27-30, 34-38, 42-45, and 48-51 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0083439 (hereinafter “Eldering”), (v) the Examiner rejected claims 31, 39, and 52 under 35 U.S.C. § 103(a) as being unpatentable over Eldering in view of U.S. Patent No. 7,017,173 (hereinafter “Armstrong”), and (vi) the Examiner rejected claim 26 under 35 U.S.C. § 103(a) as being unpatentable over Eldering in view of U.S. Patent Application Publication No. 2005/0267994 (hereinafter “Wong”).

### **2. Information Disclosure Statements**

Accompanying the Office Action were copies of Information Disclosure Statements by Applicant filed on August 13, 2002 and April 5, 2007. On the Information Disclosure Statements, lines were drawn through some of the cited references and the Examiner did not record his initials by these references.

On the Information Disclosure Statement (IDS) filed August 13, 2002, the Examiner indicated that “no copies” were provided for some of the cited references. Accordingly, Applicant files herewith (i) an IDS that cites the references for which no

copies were provided, (ii) copies of the omitted references, and (iii) the required fee under 37 C.F.R. § 1.17(p). Applicant respectfully requests that the Examiner consider the references cited in the IDS filed herewith.

On the IDS filed April 5, 2007 (which was prior to the mailing of a first Office Action on the merits), the Examiner indicated that the reference “International Search Report for PCT Application No. PCT US01/32169” is not a publication. 37 C.F.R. § 1.98 indicates that any IDS filed under 37 C.F.R. § 1.97 shall include a list of all patents, publications, applications, or *other information submitted for consideration by the Office*. (Emphasis added). Even if the International Search Report for PCT Application No. PCT US01/32169 is not a publication, Applicant submits that it qualifies as “other information” and Applicant respectfully requests that the Examiner consider this reference.

### **3. Amendments and Pending Claims**

Applicant has amended claims 1-3, 5, 11-15, 19, 31, 38, 39, 42-45, and 48-52, cancelled claims 4, 6, 9, 10, 16, 25-30, 34-37, and added new claims 55-67. Claims 1-3, 5, 7, 8, 11-15, 17-24, 31, 38, 39, 42-45, 48-52, and 55-67 are pending, of which claims 1, 38, 42, 44, 49, and 51 are independent.

### **4. Response to Potential Claim Objection under 37 C.F.R. § 1.75**

The Examiner indicated that should claims 5 (or 8) be found allowable, claim 6 (or 16) will be objected to under 37 C.F.R. § 1.75 as being a substantial duplicate thereof. Applicant has cancelled claims 6 and 18.

## **5. Response to Claim Objections**

The Examiner objected to claims 39, 43, 45, 48, 50, and 52 for depending from claims 37, 41, 43, 43, 48, and 50, respectively. Applicant has amended claims 39, 43, 45, 48, 50, and 52 to depend from claims 38, 42, 44, 49, and 51, respectively.

The Examiner indicated claims 49 and 51 should be amended to include “capable of being executed by a computer processor” to make it clear that the medium stores computer-executable instructions. Applicant has amended claims 49 and 51 to clarify that the computer program product comprises instructions executable by a processor.

Applicant submits that the amendments to claims 39, 43, 45, and 48-52 overcome the Examiner’s objections. Applicant respectfully requests that the Examiner withdraw the objection to claims 39, 43, 45, and 48-52.

## **6. Response to Claim Rejections**

### **a. Claims Rejected under 35 U.S.C. § 112, second paragraph**

The Examiner rejected claims 14, 25, and 26 because there was no antecedent basis for “the rules.” Applicant has amended claim 14 to recite “with a placement rule and a weight rule of the ad” instead of “with the ads placement rule and weight rule.” Applicant submits that this amendment overcomes the Examiner’s rejection to claim 14 under 35 U.S.C. § 112, and Applicant respectfully requests that the Examiner withdraw this rejection of claim 14. Applicant has cancelled claims 25 and 26. Applicant submits that the rejection of claims 25 and 26 under 35 U.S.C. § 112 is now moot, and Applicant respectfully requests that the Examiner withdraw this rejection of claims 25 and 26.

The Examiner rejected claim 19 under 35 U.S.C. § 112, second paragraph. The Examiner indicated it is unclear what step is actually being performed. Applicant’s

amendment to claim 19 clarifies that the next ad to be displayed is an ad displayable in a predetermined location of the display. Applicant submits that this amendment to claim 19 overcomes the Examiner's rejection of claim 19 under 35 U.S.C. § 112, and Applicant respectfully requests that the Examiner withdraw this rejection of claim 19.

The Examiner rejected claim 30 under 35 U.S.C. § 112, second paragraph, because there was no antecedent basis for "an ad's placement value." Applicant has cancelled claim 30. Applicant submits that the rejection of claim 30 under 35 U.S.C. § 112 is now moot, and Applicant respectfully requests that the Examiner withdraw this rejection of claim 30.

The Examiner rejected claims 31, 39, and 52 under 35 U.S.C. § 112, second paragraph. The Examiner indicated it is unclear if Applicant is positively requiring entering a pause mode. Applicant has amended claim 31 to recite "at the client, entering a pause mode to pause currently viewed programming," and Applicant has amended claims 39 and 52 so that claims 39 and 52 recite "the ad opportunity occurs when a user pauses a currently viewed program." Applicant submits that the amendments to claims 31, 39, and 52 overcome the Examiner's rejection of claims 31, 39, and 52 under 35 U.S.C. § 112, and Applicant respectfully requests that the Examiner withdraw this rejection of claims 31, 39, and 52.

The Examiner rejected claim 34 under 35 U.S.C. § 112, second paragraph, because the Examiner did not understand what Applicant was claiming. Applicant has cancelled claim 34. Applicant submits that the rejection of claim 34 under 35 U.S.C. § 112 is now moot, and Applicant respectfully requests that the Examiner withdraw this rejection of claim 34.

The Examiner rejected claims 36 and 37 under 35 U.S.C. § 112, second paragraph. Applicant has cancelled claims 36 and 37. Applicant submits that the rejection of claims 36 and 37 under 35 U.S.C. § 112 is now moot, and Applicant respectfully requests that the Examiner withdraw this rejection of claims 36 and 37.

**b. Claims Rejected under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a)**

The Examiner rejected claims 1-25, 27-30, 34-38, 42-45, and 48-51 under 35 U.S.C. § 102(e) as being anticipated by Eldering. Under M.P.E.P. § 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Applicant has amended independent claims 1, 38, 42, 44, 49, and 51. Independent claims 1, 38, 42, 44, 49, and 51 now clearly distinguish over Eldering, because Eldering does not disclose or suggest each and every element as recited in any of these claims.

In particular, Eldering fails to disclose or suggest that re-evaluating the order of the ads (or the plurality of ads) includes *for each of the at least one of the ads associated with a respective weight value, multiplying the re-determined placement value associated with that ad by the weight value associated with that ad so as to determine a weighted placement value for that ad*, as recited in amended claims 1, 38, 42, 44, 49, and 51.

At best, Eldering teaches that (i) the rescheduling of advertisements (i.e., changing the ad insertion schedule) in a queue may encompass reordering an entire list of ARLs (ad resource locators) or selectively changing the first or few items on the queue list and (ii) any change in one of the viewing parameters or multiple changes in a combination of the viewing parameters may trigger rescheduling of advertisements.

(See, e.g., Eldering, paragraph 0056). Eldering also teaches that one or more tags can be assigned to each ARL in the queue and the advertisement ordering/rescheduling can be dictated based on these tags, which may identify a viewer, a program or type of program, and any other items or events which may be used to order the advertisements. (See, e.g., Eldering, paragraphs 0066 and 0067).

However, these portions of Eldering, as well as the other portions of Eldering, at a minimum, fail to teach or suggest that re-evaluating the order of the ads (or the plurality of ads) includes *for each of the at least one of the ads associated with a respective weight value, multiplying the re-determined placement value associated with that ad by the weight value associated with that ad so as to determine a weighted placement value for that ad*, as recited in amended claims 1, 38, 42, 44, 49, and 51.

The amendments to claims 1, 38, 42, 44, 49, and 51 each include adding, in one way or another, an element that recites “weight value.” Original claim 10 recited, inter alia, that “re-evaluation of the plurality of ads includes evaluation of a **weight value** for at least one of the plurality of ads.” (Emphasis added). In rejecting claim 10, the Examiner argued that Eldering teaches (i) that each ad can include various targeting parameters such as time of day, program being watched, identified viewer, etc, (ii) the re-ordering of an ad queue according to matched parameters is taken to represent re-ordering a placement value according to a **weight value** for the ads and their parameters, and the ads on the top of the queue are taken to have higher weighted ad placement values. (Office Action, page 5, emphasis added). In rejecting claim 10, the Examiner cited to Figures 5 and 6 and paragraph 0081 of Eldering.

Assuming arguendo that the parameters disclosed by Eldering in paragraph 0081 disclose the claimed “re-determined placement value” and the claimed “weight value,” which Applicant does not concede, Eldering does not teach or suggest that the parameters are multiplied to determine a weighted placement value, and thus Eldering does not teach or suggest *multiplying the re-determined placement value associated with an ad by the weight value associated with that ad so as to determine a weighted placement value for that ad*, as recited in claims 1, 38, 42, 44, 49, and 51.

Because Eldering does not teach or suggest each and every element of claims 1, 38, 42, 44, 49, and 51, Eldering fails to anticipate claims 1, 38, 42, 44, 49, and 51 under 35 U.S.C. § 102(e). Additionally, without conceding any assertion made by the Examiner in rejecting claims 2-3, 5, 7, 8, 11-15, 17-24, 31, 39, 43, 45, 48, 50, and 52, Applicant submits that dependent claims 2-3, 5, 7, 8, 11-15, 17-24, 31, 39, 43, 45, 48, 50, and 52 are allowable over Eldering for at least the reason that each of these claims depend from one of allowable claims 1, 38, 42, 44, 49, and 51. Further, Applicant submits that new dependent claims 55-67 are allowable over Eldering for at least the reason that each of the these claims depends from one of allowable claims 1, 38, 42, 44, 49, and 51.

## **7. Conclusion**

Applicant believes that all of the pending claims have been addressed in this response. However, failure to address a specific rejection or assertion made by the Examiner does not signify that Applicant agrees with or concedes that rejection or assertion.

For the foregoing reasons, Applicant submits that claims 1-3, 5, 7, 8, 11-15, 17-24, 31, 38, 39, 42-45, 48-52, and 55-67 are in condition for allowance. Therefore, Applicant respectfully requests favorable reconsideration and allowance of all of the claims.

Respectfully submitted,

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